d.) Remarks.

Claims 1-40 are currently pending. Claims 16-28 and 38-40 are withdrawn as being drawn to a non-elected invention; Claims 9-15 and 29-31 are withdrawn as being drawn to a non-elected species. Applicants restate their agreement that the species of Figures 2 and 3 are patentably distinct, and further restate their position that claims 9-15 and 29-31 read on the species of Figure 2 but do not admit that claims 9-15 and 29-31 do not read on the species of Figure 3.

Remarks Regarding 35 U.S.C. § 103

Claims 1-8 and 32-37 stand rejected under 35 U.S.C. § 103(a), as allegedly obvious over U.S. Patent No. 6,829,587 ("Stone").

Applicant respectfully traverses this rejection and all comments made in the Office Action. All remarks concerning previously cited references from the May 2, 2005 response are hereby incorporated by reference. Further, the new reference cited fails to render any claim obvious.

General Comments:

The Patent Office cited Stone as disclosing a computerized method over a network "for automatic rearranging of a selected product, e.g. cols. 5-6, 1700, 4000, and display a preview to a user, e.g. cls. 13-64." However, upon a careful reading of Stone, it will be clear that Stone merely discloses a method for forcing a user to create or modify advertisements in accordance with predetermined criteria.

"This invention improves on the prior art by creating a controlled, managed environment for the sellers in which to create their presentations. This invention automatically applies not only editing, style, graphics, data, and content controls but also design specification and architectural requirements to the design environment of all forms of specific member media venues or outlets, both electronic print and all other media formats." (Stone: Col. 4, line 67 – Col. 5, line 8; also see Stone: Col. 28, lines 32-39.) Applicants' position is further reinforced by the statement "This is accomplished by using different presentation formatting guidelines and rules for the targeted directories or indexes. This single-entry and automatically distributed

method is more efficient than managing each directory or index individually." (Stone: Col. 5, lines 20-22.)

"The present invention directs all presentations through a central controller, which standardizes the presentations within the style, editing, and content standards set by the controller standards for each presentation, directory, or index.. All electronic interactive presentations are optimized for presentation search visibility by the controller and can then be globally refined, based on traffic analysis." (Stone: Col. 5, lines 58-65.)

"The present invention edits and structures data and information from an individual seller, at a single location, into consistent, designed and controlled presentations. "(Stone: Col. 13, lines 28-31.).

"The Presentation Database 1640 will have data fields containing information that relates to the Seller's choice of media or venues as well as the presentation of their products, goods, or services offered to the Buyers. The data fields held by Presentation Database 1640 will vary from seller type to seller type, depending on the design of the presentations and the types of resident and non-resident media offered by the given instance of the present invention. As an example, if an embodiment of the present invention were configured to present lodging facilities, the Presentation Database 1640 might contain fields for facility description, facility photos, room descriptions, room photos, facility amenities, room amenities, room service menu, payment types accepted, meeting and reception services offered, meeting rooms, photos of meeting rooms, policies, rates, special package offers, media or venue choices, and any other information to assist in the presentation and sale of the lodging. The Seller Interface 4000, specifically the Configuration and Presentation Program 4715 FIG. 2c, will prompt the Seller for the necessary information for the presentations and non-resident media they have selected." (Stone: Col. 17, lines 29-56; also see Stone: Col. 26, lines 44-65.)

"The Presentation Rules Database 1650 will have data fields containing information that controls and limits the style and editing of the presentations created by the Presentation Generation Program 1710. ... The data fields held by the Presentation Rules Database 1650 will vary from seller type to seller type, as well as from one media type to another, depending on the design of the presentations. Some of the fields that might be maintained are presentation templates; blocked words; blocked phrases; blocked references; presentation cost and options;

publication dates and deadlines; blocked URLs; grammar guidelines; spelling dictionaries; presentation size restrictions; photo or graphics specifications such as size, compression, and file format; and any other guidelines, benchmarks, or controlling algorithms." (Stone: Col. 18, lines 7-28; also see Col. 27, lines 11-32.)

Therefore, as shown above, Stone goes into great detail about how different fields are to be set up, what the different fields might be, that the computer checks to make sure that the information or data in a field meets the requirements for the media and can edit or structure the data, etc. However, Stone neither suggests nor discloses the claimed invention, which requires: "displaying on a computer a plurality of advertising formats for selection by the user; processing the user selection; displaying on the computer, in response to selection by the user, a template that corresponds to a selected one or more of the plurality of advertising formats; displaying on the computer a plurality of product references for selection by the user; displaying on the template at least one selected product reference to create a proposed advertisement; and automatically rearranging the selected product reference to the selected format to create a preview of the proposed advertisement; and displaying the preview to the user. Rather, Stone discloses predetermined fields and rules for creating advertisements usable across a plurality of media.

Stone does not discuss or disclose the user selection of an advertising format, presentation to the user of templates that correspond to that format, presentation to the user of product references, and automatically rearranging the selected product reference to the selected format to create a preview of the advertisement.

The Patent Office admits Stone does not disclose the claimed advertising format or the advertising mechanism for creating a proposed advertisement using a computer. However, the Patent Office purports to combine the presentation of data in Stone with the claimed advertising format using an insufficient motivation statement.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 2221 U.S.P.Q. 929, 933 (C.A.F.C. 1984).

The Patent Office uses "the motivation to have provided for such for Stone would have been the use of common knowledge computer graphic display techniques." Computer graphic display techniques are not obvious to the user, who is an advertiser.

The Patent Office relies on "official notice" that the claimed advertising mechanism for creating a proposed advertisement claimed, sans the use of a computer, has been common knowledge in the advertising art to render all limitations obvious over Stone without supporting documentary evidence to support the Examiner's conclusion.

Under MPEP § 2144.03, "[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known" *In re Ahlert,*165 USPQ 418 (CCPA 1970). This is not the case in the instant application. The claimed advertising mechanism is not capable of instant and unquestionable demonstration of being well-known, nor was it described in any of the cited references. Further, "[i]t is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based" *In re Zurko,* 527 U.S. 150 (1999). The Patent Office fails to provide any substantial evidence of any of the "common knowledge" assertions in this rejection.

Applicant respectfully requests the Patent Office to provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding of what is known in the art in accordance with 37 CFR 1.104(d)(2) and satisfy the substantial evidence test.

Specific Comments Regarding Independent Claims 1, 32, and 35.

Claim 1 requires "displaying on a computer a plurality of advertising formats for selection by the user; ... displaying on the computer, in response to selection by the user, a template that corresponds to a selected one or more of the plurality of advertising formats." Claim 32 requires "selecting an advertising format from a plurality of advertising formats stored on a computer; displaying on the computer, in response to selection by the user, a template that corresponds to a selected one or more of the plurality of advertising formats, said template including a plurality of advertising areas." Claim 35 requires "selecting an advertising format from a plurality of advertising formats stored on a computer; displaying on

the computer, in response to selection by the user, a template that corresponds to a selected one or more of the plurality of advertising formats, said template including a plurality of advertising areas." Stone discloses allowing the user to select the media for the advertisement; once a media is selected, the format is fixed – there are predetermined guidelines for advertisements for that media and the advertisement must meet those guidelines. Stone provides fields for text entry and places for pictures, and automatically checks an advertisement to verify that the advertisement meets the guidelines for the selected media; as guidelines and automatic verification and notification are specified, there is no motivation to provide templates. Thus, Stone does not in any way suggest that the user is presented with a plurality of advertising formats or, once an advertising format is chosen, that the user is presented with a plurality of templates for that selected advertising format. Further, as there are predetermined fields, there is no motivation in Stone to provide templates.

Specific Comment Regarding Dependent Claim 5.

Claim 5 depends from Claim 1 and further requires that "the step of displaying on the computer a plurality of product references for selection by the user comprises: displaying on the computer a menu of a plurality of vendors for selection by the user; and displaying on the computer, in response to selection of a vendor by the user, a plurality of product references that correspond to a the selected vendor." The Patent Office did not discuss this claim or any element thereof. Further, Stone does not discuss this either. In particular, Stone simply discloses allowing the user to select an advertising media, and then allows the user to select or edit his own presentation for use on the media. Assuming arguendo that selection of a media is equivalent to selection of a vendor, Stone neither suggests nor discloses that, once a vendor is selected, product references for that vendor be displayed for the user to select. Further, there is no motivation or incentive in Stone to do so as Stone is only concerned with a user being able to create or edit his own presentation for use on different media.

Specific Comment Regarding Dependent Claim 6:

Claim 6 depends from Claim 1 and further requires that "the step of displaying on the template at least one selected product reference comprises: displaying on the template at least

one advertisement area for selection by the user; displaying on a the selected advertisement area at least one selected product reference; and displaying on the selected advertisement area information for the at least one selected product reference." The Patent Office did not discuss this claim or any element thereof. Further, Stone does not discuss this either. In particular, Stone simply discloses that the user can select the media, and then the computer program determines whether the selected presentation meets the requirements for that media. Stone neither suggests nor discloses that the user can select the area of the media in which the advertisement will occur, or displaying the advertisement as it will appear once fit into that area. Further, there is no motivation or incentive in Stone to do so as Stone is only concerned with a user being able to create or edit his own presentation for use on different media.

Specific Comment Regarding Independent Claim 35.

Claim 35, in addition to the requirements discussed above, also requires "specifying at least one rule of priority for laying out the plurality of product references onto the plurality of advertising areas; generating an advertisement whereby the plurality of product references are automatically placed onto the plurality of advertising areas in accordance with the at least one rule of priority." Stone discloses inspecting an advertisement to determine if it meets the guidelines for a selected media. Stone also indicates that a user can specify a priority as to when the advertisement will be processed for publishing. Stone, however, does not discuss how the advertisements are to be laid out on the media or any rules or priorities for doing so.

Specific Comment Regarding Dependent Claim 36.

Claim 36 depends from Claim 35 and further requires that "the rule of priority is to maximize the size of the images for each of the selected products, when said product references are laid-out on a template." As mentioned above, Stone discloses inspecting an advertisement to determine if it meets the guidelines for a selected media and Stone also indicates that a user can specify a priority as to when the advertisement will be processed for publishing. Stone, however, does not discuss the layout of the advertisements, nor that the product references, such as advertisements, should be laid out on the template in a manner which maximizes the size of the images.

Specific Comment Regarding Dependent Claim 37.

Claim 37 depends from Claim 35 and further requires that "the rules of priority are chosen from the group consisting of: maximum size of product image; maximum number of advertised products per page; minimum separation between product references; maximum font size; minimum font size; predetermined number of product references per page; grouping by manufacturer; and grouping by product category." As mentioned above, Stone discloses inspecting an advertisement to determine if it meets the guidelines for a selected media and Stone also indicates that a user can specify a priority as to when the advertisement will be processed for publishing. Stone, however, does not discuss the layout of the advertisements, nor that the product references, such as advertisements, should be laid out on the template in a manner which meets any of the specified rules.

Subsequent Office Action should be Non-Final

Although it is believed that the claims have been shown to be allowable over Stone, in the event that the Patent Office deems otherwise, it is respectfully suggested that the next Office Action should be a non-final Office Action, especially if the Patent Office again relies upon Stone. The Patent Office referred to Stone in broad general terms, pointed to Stone in a sweeping manner (almost the entire specification, e.g., "Cols. 13-64"), and generally failed to provide any specific guidance or direction as to the relevance of Stone. Applicants appreciate that the Patent Office has limited resources to devote to each patent application, but Applicants do not believe that is justification for placing the burden and cost on Applicants to plod through Stone in an attempt to try to find out what the Patent Office might have considered to be relevant. Indeed, 37 CFR Section 1.104(c)(2) requires: "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." Stone is clearly a complex reference as it has 35 sheets of drawings and over 63 columns of text, not including the claims or the abstract. Further, Stone states that different inventions are described: "The present invention is a method and apparatus that allows individual competing, as well as complementing suppliers, vendors, service providers, purveyors, and other types of sellers as companies, individuals, or as any other entity, controlled design and publication of print media advertising and outreach. The present invention allows for standards or guidelines to be set by print media and then automatically applied in the creation of advertising or outreach presentations." (Stone: Abstract.) It is also noted that Stone '587 is a continuation of U.S. Patent No. 6,446,045 to Stone, and Stone '045 states "The present invention is a method and apparatus that allows competing as well as complementing suppliers, vendors, service providers, purveyors, and other types of sellers internal inventory management as well as controlled design and publication of presentations for external near real-time interactive access to buyer-centered presentation, sales, distribution, and confirmation systems as well as other traditional media advertising and outreach. The Automated Media Presentation Generator including a Publication and Placement Control Engine, integrates a Distributed Sales and Inventory Control structure with Processing and Communications Resource Saver, and further provides a Reservation, Access, and

Verification System replacing traditional ticket and confirmation methods." (Stone '045: Abstract.) Finally, the Summary section (both Stone patents: Cols. 3 and 4) cites several inventions. Thus, it is respectfully requested that any future Office Action other than an allowance should be non-final and, if referring to Stone, point out the relevant part of Stone with specificity.

Conclusion

In view of the foregoing remarks, reconsideration of the application and issuance of a Notice of Allowance is respectfully requested. If there are any issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the number below.

Should additional fees be necessary in connection with the filing of this Responsive Amendment, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge **Deposit Account No. 50-1682 for any such fees, referencing Attorney Docket No. 144797.00100**; and applicant hereby petitions for any needed extension of time not otherwise accounted for with this submission.

Respectfully submitted,
Powell Goldstein LLP

Date: February 10, 2006

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